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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/094,949	06/15/1998	DWIGHT A. MERRIMAN	1153	9057

26646 7590 10/24/2003

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EXAMINER

HARLE, JENNIFER I

ART UNIT	PAPER NUMBER
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3627

DATE MAILED: 10/24/2003

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 25

Application Number: 09/094,949
Filing Date: June 15, 1998
Appellant(s): MERRIMAN ET AL.

Kenyon and Kenyon
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed June 27, 2003.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is substantially correct. The changes are as follows:

It is not whether the claims are obvious over any of the references but rather whether or not Kohda, et al. has the deficiencies claimed. If the deficiencies claimed are rectified by the additional prior art then Appellants' Brief is moot as they never argued the deficiencies of the 103 references or any of the motivations to combine. Appellants have only argued the independent claims 85, 90, 95 and 100. The dependent claims were not argued separately nor addressed, as set forth in the Final Office Action, Response, pg. 2. To the extent that the dependent claims rely upon the rationale well known in the art as the motivation to combine the teachings or any other motivations

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set forth, they should have been addressed in the prior office actions. Appellants only arguments set forth were that the independent claims are patentably distinguishable over Kohda, et al. (the primary reference) because 1) the phrase “receiving from an advertiser Web site feed back representing user transactions at the advertiser Web site, the user transactions resulting from user response to at least one of a plurality of direct advertisements” is not taught or suggested; 2) the characterization of Kohda, et al. is incorrect because the advertising agent’s Web server does not receive feedback from the advertiser’s Web server but rather from the advertising agent’s Weber receiving user activity information from the user’s modified Web browser, which captures this information when the user clicks on an anchor, i.e. link, in a Web page and 3) that in Kohda, et al. to the extent that user activity information, i.e. click-through/utilization of links, appears to be shared between Kohda’s advertising agent and an advertiser, it is the advertising agent that provides such information to the advertiser.

(7) *Grouping of Claims*

Appellants’ brief includes a statement that claims 85-99 and 100 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

The prior art of Record relied upon by the Examiner is:

1. Youja Kohda and Susumu Endo, Ubiquitous Advertising on the WWW: Merging Advertisement on the Browser, Computer networks and ISDN Systems, Vol. 28, 1996, pp. 1493-1499.

2. Frank V. Cespedes and H. Jeff Smith, Database marketing: New Rules for Policy and Practice, Sloan Management Review, Summer 1993, pp. 7-21.
3. Microsoft Press Computer Dictionary Third Edition, 1997. pg. 387.
4. Bill Harvey, The Expanded ARF Model: Bridge to the Accountable Advertising Future, Journal of Advertising Research, March/April 1997, pp. 11-20.

The following ground(s) of rejection are applicable to the appealed claims:

(10) *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims:

1. Claims 85-88, 90-93, 95-98 and 100 are rejected under 35 U.S.C. 103(a). This rejection is set forth in prior Office Actions, Papers No. 15 and 18. The full rejection is set forth below for Appellants' and the Board's convenience.

Claims 85-88, 90-93, 95-98 and 100 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kohda, et al. in view of Cespedes & Smith, Database Marketing: New Rules for Policy and Practice, Sloan Management Review, Summer, 1993, pp. 7-22.

As per claims 85 and 87, Kohda, et al., teaches a method for online advertising selection (pg. 1493 - Abstract), comprising:

(a) receiving from an advertiser Web site feedback representing user transactions at the advertiser Web site, the user transactions¹ resulting from user response to at least one of a plurality of direct advertisements; (pg. 1494-1495 – 2.3 Assessing advertising agents: “Advertisements returned from the advertising agent's Web server can have links to other pages which might, for

¹ User transactions are defined as any form of explicit feedback, which a user may convey by means of a commerce engine. This interaction does not have to be completed on the internet but may be completed via telephone, fax, mail, interactive television. These transactions encompass but are not limited to filling out forms/surveys, placing orders, supplying credit card numbers, executing a download, etc.

example, be more detailed advertisements or online order forms for the advertised goods or services and 2.1 Making contracts with advertising agents: “The advertisements are stored on the agent’s Web server. Otherwise they might be kept on the advertiser’s Web servers with just the links to them stored in the agent’s Web server.” Thus, receiving the feedback from the user by following the links, i.e. click-through, and the tracking of order forms received from the advertiser Web site is taught by Kohda, et al.);

(b) receiving a request to display a direct advertisement to a user (pg. 1495 – 2.2

Delivering advertisements to customers); and

(c) selecting, in response to the request, one of the plurality of direct advertisements for display, (pg. 1495 - 2.2 Delivering advertisements to customers – the advertising agent can tailor advertisements for individuals and their current interests).

Kohda, et al., does not teach that the selection of the advertisement be based at least in part upon the advertiser feedback. Utilizing advertiser feedback representing user transactions is not a new concept in selecting advertisements. Cespedes & Smith teach using database marketing using personal information such as credit card information (pg. 10 – col. 2 and pg. 12), direct-response media and e-mail between the buyer and seller (pg. 13 - col. 2), and order forms, purchases and surveys (pg. 17 - col. 1) to improve the three Ts, targeting, tailoring, and tying with consumers to permit them to receive the more relevant messages, i.e. direct advertisements, and products (pg.7). Cespedes & Smith further teach that database marketing can reduce ad clutter and other marketing related “noise” by targeting consumers most interested in the specific products and services only if the database remains current and up to date otherwise it becomes more of a liability than an asset (pg. 18 – Data Management). Moreover, Cespedes & Smith teach that the best response marketers

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can when categorizing, i.e. targeting and tailoring, is to use more data in their segmentation schemes as there is much evidence to indicate systematic difference as to how consumers respond in controlled/survey/samplings and how they behave in the marketplace (pg. 19). It would have been obvious to one of ordinary skill in the art at the time of the invention to have selected the advertisement at least in part based upon the advertiser feedback in the method of Kohda, et al. as taught Cespedes & Smith to enhance advertisement selection. Further, it would increase the efficiency and enhance customer satisfaction with the method.

The system claims 90 and 92 are rejected for the same reasons set forth in claims 85 and 87 above.

The medium claim 95, and 97 are rejected for the same reasons set forth in claims 85 and 87 above.

Method claim 100 is rejected for the same reasons set forth in claim 85.

As per claim 86, Kohda, et al. teaches as taught above. However, Kohda, et al. does not teach that the selection is based at least in part upon its historical statistical conversion rate. As set forth in previous actions and not responded to in the arguments in this CPA, Kohda, et al. does disclose recording the actions of users in relation to a particular advertisement (i.e., reading its details or buying the goods or services, historical statistics on these transactions) in order to prove the effectiveness of the advertising agent (pg. 1498, col. 2, Section 4). This type of statistical analysis of marketing programs is well known, i.e. sending out coupons and counting the number of redeemed coupons in a particular targeted area or tracking repeat customers of catalog shoppers. It would have been obvious for one of ordinary skill in the art at the time the invention was made to utilize a historical statistical conversion rate as at least a part of the basis for selection of one of the

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plurality of direct advertisements for the reasons set forth above. Additionally, these statistics would enable the advertising agent to prove effectiveness of the advertising to the advertiser and other potential clients to make the advertising agent more competitive and profitable and entice current clients to remain with them and encourage new clients to join the firm.

The system claim 91 is rejected for the same reasons set forth in claim 86 above.

The medium claim 95 is rejected for the same reasons set forth in claim 86 above.

As per claim 88, Kohda does not teach that the advertiser feedback is received via e-mail.

As set forth in previous actions and not responded to in the arguments to in this CPA, however, email is a well-known method of feedback. It would have been obvious for one of ordinary skill in the art at the time the invention was made to select email as the feedback signal as e-mail is a fast and economical method of communication. These advantages are well known to those skilled in the art.

The system claim 93 is rejected for the same reasons set forth in claim 88 above.

The medium claim 98 is rejected for the same reasons set forth in claim 88 above.

Further Appellants' only argued the independent claims 85, 90, 95, and 100 in their response to the examiner office action nor was any mention made of the lack of analysis under 112 sixth paragraph. The dependent claims are never separately addressed or argued and any claims directed towards them were deemed waived, including motivations to combine as they should have been previously addressed in prior office action. Appellants' argued that the independent claims. 85, 90, 95, and 100 were patentably distinguishable over Kohda, et al. because the phrase "receiving from an advertiser Web site feedback representing user transactions at the advertiser Web site, the user transactions resulting from user response to at least one of a plurality of direct advertisements" was

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not taught or suggested. Appellants further argued that the examiner's characterization of Kohda, et al. was incorrect because the advertising agent's Web server does not receive feedback from the advertiser's Web server but rather the advertising agent's Web server receives user activity information from the user's modified Web browser, which captures this information when the user clicks on an anchor, i.e. link, in a Web page. However, the click-throughs/utilization of links to reach the advertiser's own Web page is feedback from the advertiser's Web server because the click-through/link counted, i.e. "user activity" as defined by Appellants, is a direct result of the advertiser's Web site and thus is feedback from the advertiser's Web server -- regardless of the means used to capture the data, in this case a filter on user's machine passing on the information to the advertising agent. Thus, the examiner did not find this argument persuasive.

Additionally, Appellants argued that to the extent that user activity information, i.e. click-through/utilization of links, appears to be shared between Kohda's advertising agent and an advertiser, it is the advertising agent that provides such information to the advertiser. The examiner has never argued that point. In fact, that is the specific reason/deficiency pointed out in the §103 rejection, i.e. that Kohda, et al. does not teach utilizing this information as a means of selecting the advertisement. In response to Appellants' arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Appellants' failed to address the combination of references.

2. Claims 89, 94 and 99 are rejected under 35 U.S.C. 103(a). This rejection is set forth in prior Office Actions, Papers No. 15 and 18. The full rejection is set forth below for Appellants' and the

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Board's convenience. The examiner notes that these are all dependent claims and were not specifically argued in the previous office actions as set forth above.

Claims 89, 94 and 99 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kohda, et al. in view of Cesepdes & Smith as applied to claim 85, 90 and 95 above, and further in view of the Microsoft Press Computer Dictionary Third Edition, 1997, pg. 387.

As per claim 89, neither Kohda, et al. nor Cespedes & Smith specifically teach that the advertiser feedback is received via a proxy server. However, Kohda does teach the use of a proxy server as part of a filter, agent to user and agent to advertiser, with a ubiquitous advertising on the web and merging advertisements on browsers. Pg. 1498, Section 3.3. A proxy server acts as a firewall component that manages internet traffic to and from a LAN ...and can improve performance by supplying frequently requested data ... and can filter and discard requests the owner does not consider appropriate, such as requests for unauthorized access to proprietary files. Microsoft Dictionary, pg. 387. Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention to utilize the proxy server to manage the internet traffic, i.e. feedback, as taught by the Microsoft Dictionary, in the method of online advertisement selection as taught by Kohda, et al. because proxy servers clearly protect the integrity of the advertising agent and advertisers networks. Steps to enhance the security and integrity of a client's or a business's systems represent an obvious modification to the prior process taught by Kohda, et al.

The system claim 94 is rejected for the same reasons set forth in claim 89.

The medium claim 99 is rejected for the same reasons set forth in claim 89.

Once again Appellants' only argued the independent claims 85, 90, 95, and 100 in their response to the examiner office action nor was any mention made of the lack of analysis under 112

sixth paragraph. The dependent claims are never separately addressed or argued and any claims directed towards them were deemed waived, including motivations to combine as they should have been previously addressed in prior office action. Appellants' argued that the independent claims. 85, 90, 95, and 100 were patentably distinguishable over Kohda, et al. because the phrase "receiving from an advertiser Web site feedback representing user transactions at the advertiser Web site, the user transactions resulting from user response to at least one of a plurality of direct advertisements" was not taught or suggested. Appellants further argued that the examiner's characterization of Kohda, et al. was incorrect because the advertising agent's Web server does not receive feedback from the advertiser's Web server but rather the advertising agent's Web server receives user activity information from the user's modified Web browser, which captures this information when the user clicks on an anchor, i.e. link, in a Web page. However, the click-throughs/utilization of links to reach the advertiser's own Web page is feedback from the advertiser's Web server because the click-through/link counted, i.e. "user activity" as defined by Appellants, is a direct result of the advertiser's Web site and thus is feedback from the advertiser's Web server – regardless of the means used to capture the data, in this case a filter on user's machine passing on the information to the advertising agent. Thus, the examiner did not find this argument persuasive.

Additionally, Appellants argued that to the extent that user activity information, i.e. click-through/utilization of links, appears to be shared between Kohda's advertising agent and an advertiser, it is the advertising agent that provides such information to the advertiser. The examiner has never argued that point. In fact, that is the specific reason/deficiency pointed out in the §103 rejection, i.e. that Kohda, et al. does not teach utilizing this information as a means of selecting the advertisement. In response to Appellants' arguments against the references individually, one cannot

show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Appellants' failed to address the combination of references.

3. Claims 85-88, 90-93, 95-98 and 100 are rejected under 35 U.S.C. 103(a). This rejection is set forth in prior Office Actions, Papers No. 15 and 18. The full rejection is set forth below for Appellants' and the Board's convenience.

Claims 85-88, 90-93, 95-98 and 100 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kohda, et al. in view Bill Harvey, The Expanded ARF Model: Bridge to the Accountable Advertising Future, Journal of Advertising Research, March/April 1997, pp. 11-20.

As per claims 85 and 87, Kohda, et al., teaches a method for online advertising selection (pg. 1493 - Abstract), comprising:

(a) receiving from an advertiser Web site feedback representing user transactions at the advertiser Web site, the user transactions² resulting from user response to at least one of a plurality of direct advertisements; (pg. 1494-1495 – 2.3 Assessing advertising agents: “Advertisements returned from the advertising agent's Web server can have links to other pages which might, for example, be more detailed advertisements or online order forms for the advertised goods or services and 2.1 Making contracts with advertising agents: “The advertisements are stored on the agent's Web server. Otherwise they might be kept on the advertiser's Web servers with just the links to them stored in the agent's Web server.” Thus, receiving the feedback from the user by following

² User transactions are defined as any form of explicit feedback, which a user may convey by means of a commerce engine. This interaction does not have to be completed on the internet but may be completed via telephone, fax, mail, interactive television. These transactions encompass but are not limited to filling out forms/surveys, placing orders, supplying credit card numbers, executing a download, etc.

the links, i.e. click-through, and the tracking of order forms received from the advertiser Web site is taught by Kohda, et al.);

(b) receiving a request to display a direct advertisement to a user (pg. 1495 – 2.2 Delivering advertisements to customers); and

(c) selecting, in response to the request, one of the plurality of direct advertisements for display, (pg. 1495 - 2.2 Delivering advertisements to customers – the advertising agent can tailor advertisements for individuals and their current interests).

Kohda, et al., does not teach that the selection of the advertisement be based at least in part upon the advertiser feedback. Utilizing advertiser feedback representing user transactions is not a new concept in selecting advertisements. Harvey teaches that the Internet offers important opportunities for learning how to use interactivity within the advertising process to add to advertising effectiveness, i.e. use these tools to get the sales you want (pg. 11). Harvey teaches that advertisers want to pay for the number of people that are reached by the actual ad not the banner, i.e. at the minimum the click-through (pg. 12).³ Harvey further teaches that additional user transactions can be used in pricing such as advertising leads – measuring those who have sought more information, e.g. requested a brochure via an 800 number, activated information requested hotlinks within an advertiser's website..., using reaction to the banner. He also includes from the traditional ARF model sales/orders (pg. 15). It would have been obvious to one of ordinary skill in the art at the time of the invention to have selected the advertisement at least in part based upon the advertiser feedback based upon user transactions at the advertiser web site in the method of Kohda, et al. as taught in Harvey to enhance advertisement selection because the advertisers want it, it

³ In fact, Proctor & Gamble set industry practice by pioneering this deal with Yahoo in 1996 (pg. 13).

enhances accountability. Further, it would increase the efficiency and enhance customer satisfaction with the method.

The system claims 90 and 92 are rejected for the same reasons set forth in claims 85 and 87 above.

The medium claim 95, and 97 are rejected for the same reasons set forth in claims 85 and 87 above.

Method claim 100 is rejected for the same reasons set forth in claim 85.

As per claim 86, Kohda, et al. teaches as taught above. However, Kohda, et al. does not teach that the selection is based at least in part upon its historical statistical conversion rate. As set forth in previous actions and not responded to in the arguments in this CPA, Kohda, et al. does disclose recording the actions of users in relation to a particular advertisement (i.e., reading its details or buying the goods or services, historical statistics on these transactions) in order to prove the effectiveness of the advertising agent (pg. 1498, col. 2, Section 4). Moreover, Harvey extends this teachings to apply to a model of ad response to the internet in an extended stage, Loyal Customers, essentially a count of leads converted to purchasers who are favorably predisposed to the offering and who have continued purchasing the product or service over time. Thus, this type of statistical analysis of marketing programs was well known, i.e. sending out coupons and counting the number of redeemed coupons in a particular targeted area or tracking catalog customers who are repeat purchasers for mailing lists. It would have been obvious for one of ordinary skill in the art at the time the invention was made to utilize a historical statistical conversion rate as at least a part of the basis for selection of one of the plurality of direct advertisements for the reasons set forth above. Additionally, these statistics would enable the advertising agent to prove effectiveness of the

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advertising to the advertiser and other potential clients to make the advertising agent more competitive and profitable and entice current clients to remain with them and encourage new clients to join the firm.

The system claim 91 is rejected for the same reasons set forth in claim 86 above.

The medium claim 95 is rejected for the same reasons set forth in claim 86 above.

As per claim 88, Kohda does not teach that the advertising feedback is received via e-mail.

As set forth in previous actions and not responded to in the arguments to in this CPA, however, email is a well-known method of feedback. It would have been obvious for one of ordinary skill in the art at the time the invention was made to select email as the feedback signal as e-mail is a fast and economical method of communication. These advantages are well known to those skilled in the art.

The system claim 93 is rejected for the same reasons set forth in claim 88 above.

The medium claim 98 is rejected for the same reasons set forth in claim 88. above.

Once again Appellants' only argued the independent claims 85, 90, 95, and 100 in their response to the examiner office action nor was any mention made of the lack of analysis under 112 sixth paragraph. The dependent claims are never separately addressed or argued and any claims directed towards them were deemed waived, including motivations to combine as they should have been previously addressed in prior office action. Appellants' argued that the independent claims. 85, 90, 95, and 100 were patentably distinguishable over Kohda, et al. because the phrase "receiving from an advertiser Web site feedback representing user transactions at the advertiser Web site, the user transactions resulting from user response to at least one of a plurality of direct advertisements" was not taught or suggested. Appellants further argued that the examiner's characterization of

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Kohda, et al. was incorrect because the advertising agent's Web server does not receive feedback from the advertiser's Web server but rather the advertising agent's Web server receives user activity information from the user's modified Web browser, which captures this information when the user clicks on an anchor, i.e. link, in a Web page. However, the click-throughs/utilization of links to reach the advertiser's own Web page is feedback from the advertiser's Web server because the click-through/link counted, i.e. "user activity" as defined by Appellants, is a direct result of the advertiser's Web site and thus is feedback from the advertiser's Web server – regardless of the means used to capture the data, in this case a filter on user's machine passing on the information to the advertising agent. Thus, the examiner did not find this argument persuasive.

Additionally, Appellants argued that to the extent that user activity information, i.e. click-through/utilization of links, appears to be shared between Kohda's advertising agent and an advertiser, it is the advertising agent that provides such information to the advertiser. The examiner has never argued that point. In fact, that is the specific reason/deficiency pointed out in the §103 rejection, i.e. that Kohda, et al. does not teach utilizing this information as a means of selecting the advertisement. In response to Appellants' arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Appellants' failed to address the combination of references.

4. Claims 89, 94 and 99 are rejected under 35 U.S.C. 103(a). This rejection is set forth in prior Office Actions, Papers No. 15 and 18. The full rejection is set forth below for Appellant's and the

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Board's convenience. The examiner notes that these are all dependent claims and were not specifically argued in the previous office actions as set forth above.

As per claim 89, neither Kohda, et al. nor Bill Harvey specifically teach that the advertiser feedback is received via a proxy server. However, Kohda does teach the use of a proxy server as part of a filter, agent to user and agent to advertiser, with a ubiquitous advertising on the web and merging advertisements on browsers. Pg. 1498, Section 3.3. A proxy server acts as a firewall component that manages internet traffic to and from a LAN ...and can improve performance by supplying frequently requested data ... and can filter and discard requests the owner does not consider appropriate, such as requests for unauthorized access to proprietary files. Microsoft Dictionary, pg. 387. Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention to utilize the proxy server to manage the internet traffic, i.e. feedback, as taught by the Microsoft Dictionary, in the method of online advertisement selection as taught by Kohda, et al. because proxy servers clearly protect the integrity of the advertising agent and advertisers networks. Steps to enhance the security and integrity of a client's or a business's systems represent an obvious modification to the prior process taught by Kohda, et al.

The system claim 94 is rejected for the same reasons set forth in claim 99.

The medium claim 89 is rejected for the same reasons set forth in claim 99.

Once again Appellants' only argued the independent claims 85, 90, 95, and 100 in their response to the examiner office action nor was any mention made of the lack of analysis under 112 sixth paragraph. The dependent claims are never separately addressed or argued and any claims directed towards them were deemed waived, including motivations to combine as they should have been previously addressed in prior office action. Appellants' argued that the independent claims.

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85, 90, 95, and 100 were patentably distinguishable over Kohda, et al. because the phrase “receiving from an advertiser Web site feedback representing user transactions at the advertiser Web site, the user transactions resulting from user response to at least one of a plurality of direct advertisements” was not taught or suggested. Appellants further argued that the examiner’s characterization of Kohda, et al. was incorrect because the advertising agent’s Web server does not receive feedback from the advertiser’s Web server but rather the advertising agent’s Web server receives user activity information from the user’s modified Web browser, which captures this information when the user clicks on an anchor, i.e. link, in a Web page. However, the click-throughs/utilization of links to reach the advertiser’s own Web page is feedback from the advertiser’s Web server because the click-through/link counted, i.e. “user activity” as defined by Appellants, is a direct result of the advertiser’s Web site and thus is feedback from the advertiser’s Web server – regardless of the means used to capture the data, in this case a filter on user’s machine passing on the information to the advertising agent. Thus, the examiner did not find this argument persuasive.

Additionally, Appellants argued that to the extent that user activity information, i.e. click-through/utilization of links, appears to be shared between Kohda’s advertising agent and an advertiser, it is the advertising agent that provides such information to the advertiser. The examiner has never argued that point. In fact, that is the specific reason/deficiency pointed out in the §103 rejection, i.e. that Kohda, et al. does not teach utilizing this information as a means of selecting the advertisement. In response to Appellants’ arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re*

Merck & Co., 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Appellants' failed to address the combination of references.

(11) Response to Argument

The Appellants' argue that the examiner's non-final and Final Action are contradictory. The examiner respectfully disagrees. Appellants' appear to have failed to distinguish the examiner's arguments as to the crux of the 103, which is that Kohda, et al. does not disclose **selection** based at least in part upon the advertiser feedback. The examiner has asserted and maintains all along that Kohda, et al. disclosed obtaining feedback from a user's browser. There is no discrepancy in this argument. It is the piece of the 103 that is missing and was taught by the cited reference with the motivation to combine. It was never argued by Appellants, even though the examiner admitted that it was not disclosed by the reference. The examiner cited two different references and set forth motivations to combine them for selecting based upon feedback that was already obtained by Kohda. See the rejections set forth above. Appellants did not dispute these portions of the 103 rejections nor did they dispute the teachings of either Cespedes or Harvey. In essence Appellants treated Kohda as a 102 teaching and ignored all of the 103 reference teachings, motivations and arguments set forth by the examiner.

Appellants still merely state that it is only unclear whether the Examiner is rejecting the claims over Kohda alone or in view of the secondary references. The first sentence of the rejection states "Kohda et al. does not teach that the **selection** of the advertisement be based at least in part upon the advertiser feedback." The Remarks state that "[a]s discussed previously, Kohda, et al., ... teach that the feedback from advertising agent's advertisements can have links to other pages which The examiner agrees that Kohda, et al. ... do not teach **selecting** one of the plurality of direct

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advertisements for display based at least in part upon the advertiser feedback. Each time a form of the word select shows up the examiner wording and it is the exact word that is utilized by Appellant in their claim.

Appellants now claim that none of the secondary references provide motivation to select an advertisement based at least in part upon advertiser feedback. However, no direct arguments are provided and none of the motivations to combine are addressed. Appellant argues that since the advertisements are obtained from filters stored on the user's augmented Web browser that and based upon what the user categories the user wants to see that selecting additional targeting could not occur based at least in part upon advertiser feedback. However, Appellants have not stated why this could not occur and Kohda, et al. specifically teaches that the agent is "aware of the identify of the user and which page the user is about to read on the browser, so the advertising agent can tailor advertisements for individuals and their current interests. Thus it prevents the user from having to see advertisements that are unrelated to their current interests. (pg. 1495) If the advertisers are aware and can tailor their advertisements, there is no apparent reason why the system and method could not be modified to utilize information already obtained by the system /method as set forth under the 103 rejections. As previously set forth and argued, feedback is obtained from and advertiser Web site by the advertising agent who records the information and shares it with the advertisers (pg. 1495). See the Office Rejection set forth above.

Appellants argues that claims 85 or 90 are not anticipated or obvious because Kohda does not suggest or teach selecting an advertisement from the plurality of advertisements based upon a transaction at the advertiser's web site. Appellants define Transactions as any form of explicit feedback which a user may convey by means of a commerce engine, for example filling out a form,

placing an order, supplying a credit card number, completing a survey or lead forum, executing a software download, etc. Collecting this type of information is explicitly taught by Kohda, et al. on pg. 1495., i.e. detecting online order forms for the advertised goods or services and detecting online order forms for competitors utilizing it to send targeted advertisements again in combination with the references cited and their motivations to combine. Moreover, Cespedes and Hill teach the use of this information for selecting the advertisements as well. None of this was ever disputed by Appellants.

The Appellants argue that the examiner failed to establish a prima facie case under 112 sixth paragraph. The examiner notes for the record that claim 100 was a method claim and that the only change before final was to a computer system utilizing means for language. Claim 100 was rejected over the method claim 85 and the equivalent system claim 90 was rejected over it as well. Thus, the only argument that Appellants offer is that a complete 112 sixth analysis was not performed. If the method were to operate it must have a computer system with the pieces to operate it. In this light the examiner further illustrates the 112 sixth analysis.

Claim 100:

Means for receiving from an advertiser Web site feedback representing user transactions at the advertiser Web site, the user transactions resulting from user response to at least one of a plurality of direct advertisements; - advertising server/advertiser server can also include a proxy server (See specification pages 5-6); Kohda discloses an advertising server as previously taught – Fig.2 advertising agent's web server.

Means for receiving a request to display a direct advertisement to a user – user's browser (See specification pages 17-18); Kohda discloses a user's browser Fig. 2.


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Means for selecting, in response to the request and the advertiser feedback, one of the plurality of direct advertisement for display based on a predictive model (advertising server/advertiser server (see specification pages 5-6); Kohda teaches an advertising browser Fig.2. – advertising agent's web server.

These are still the same rejections as set forth above for the method claim 85 and the system claim 90. Thus, even with clarification the claim rejections are rendered obvious for the reasons and explanations set forth above.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,


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October 16, 2003

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